REMARKS

By this amendment, Applicant amends claims 22 and 33 to more appropriately define the present invention. Claims 1-6, 8-11, 13-22, 24-33, 37-41, and 43-46 are pending.

In the Office Action of February 26, 2004[1] ("OA"):

1.   Claims 1-6, 8, 10-11, 13-16, 27-29, 31, 32, 37-41, 43, 44, and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,440,615 to *Caccuro et al.* ("*Caccuro*") in view of U.S. Patent No. 6,496,570 to *Nimphius* ("*Nimphius*");

2.   Claims 20-22, 24-26, and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nimphius* in view of *Caccuro*;

3.   Claims 9, 30, and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Caccuro* in view of *Nimphius* in further view of U.S. Patent No. 6,088,429 to *Garcia* ("*Garcia*");

4.   Claims 17 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,259,782 to *Gallant* ("*Gallant*") in view of *Caccuro*; and

5.   Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gallant* combined with *Caccuro* in view of U.S. Patent No. 5,583,920 to *Wheeler, Jr.* ("*Wheeler*").

Applicant addresses the rejections as set forth below.

---

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

-15-

Rejection of claims 1-6, 8, 10-11, 13-16, 27-29, 31, 32, 37-41, 43, 44, and 46

Applicant traverses the rejection of claims 1-6, 8, 10-11, 13-16, 27-29, 31, 32, 37-41, 43, 44, and 46 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established based on *Caccuro* and *Nimphius*. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

A *prima facie* case of obviousness has not been established because, among other things, the references fail to teach or suggest each and every element recited in Applicant's claims.

Caccuro is directed to "the selection by a voice messaging system of a pre-recorded announcement to by played to a caller in a language determined, based upon source information..." (col. 1, lines 50-55). In particular, *Caccuro*'s "selection" is based upon information that is "indicative of where the call originated" (col. 1, lines 54-55). In *Caccuro*'s system:

> The voice messaging system a) compares the originating country code of the caller to a stored language code selection list that associates particular call origination locations with predominant language(s) spoken at those locations, and b) based on the results of the comparison, delivers the system's messages to the caller in the language that is most likely understood by the caller (col. 1, lines 59-66).

-16-

In contrast, claim 1 recites a combination including:

> identifying a group associated with a wireless subscriber when an event that indicates an error in routing a call to the wireless subscriber is detected;
>
> determining a directory number associated with the identified group and the detected event ... and
>
> generating a message by the message node based on the directory number and a profile associated with the identified group.

As affirmed by the Examiner (OA at 9), *Caccuro* does not disclose a wireless subscriber, as recited in the claim. Additionally, *Caccuro* does not teach or suggest at least "determining a directory number associated with ....[an] identified group and ... [a] detected event." Instead, *Caccuro* merely selects a pre-recorded announcement for a caller based on "where the call originated." Even if, as the Examiner contends (OA at 9), "*Caccuro* is able to detect" a particular language group associated with a caller,[2] *Caccuro*'s system does not "[determine] a directory number associated with the identified group and ... [a] detected event," as claimed. Although *Caccuro* mentions comparing source information to a stored language code selection list, such a comparison does not involve determining a directory number associated with an identified group *and a detected event*.

ARGUMENT #1

Caccuro also fails to teach or suggest "generating a message by the message node based on the directory number and a profile associated with the identified group," as claimed. According to claim 1, a message is generated based on a directory number, which is associated with an identified group and a detected event. The message, therefore, is generated based, in part, on a detected event. *Caccuro* does not teach such functionality. Instead, *Caccuro* merely describes selecting a pre-recorded announcement for a caller based on "where the call

ARGUMENT #2

---

[2] Applicant does not acquiesce to the allegation (OA at 9) that Caccuro's alleged "... technique of playing messages in different languages based on the language group of the caller is functionally equivalent to ..." features of Applicant's claims (OA at 9).

-17-

originated." Selecting an announcement based on where a call originates does not constitute "generating a message ... based on [a] directory number [which is associated with a detected event] and a profile associated with the identified group," as claimed.

Indeed, contrary to the Examiner's position, *Caccuro* describes a system entirely incongruent with the elements recited in claim 1. Selecting a voice-mail announcement based on where an incoming call originates is not consistent with "identifying a group associated with a wireless subscriber when an event that indicates an error in routing a call to the wireless subscriber is detected ... determining a directory number associated with the identified group and the detected event ... and generating a message ... based on the directory number and a profile associated with the identified group," as claimed.

Nimphius does not cure *Caccuro*'s deficiencies. *Nimphius* describes establishing announcement texts in a service control point. The reference does not teach or suggest at least the "determining" and "generating" elements recited in claim 1. Accordingly, neither *Caccuro* nor *Nimphius*, nor a combination thereof, teaches or suggests all of the features recited in claim 1. For at least this reason, a *prima facie* case of obviousness has not been established.

Moreover, a *prima facie* case of obviousness has not been established at least because the requisite motivation to combine is lacking. Determinations of *prima facie* obviousness must be supported by a finding of "substantial evidence." See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Specifically, unless "substantial evidence" found in the record supports the factual determinations central to the issue of patentability, including motivation and expectation of success, the rejection is improper and should be withdrawn.

In this case, there is no "substantial evidence" in the record to support the attempted combination of *Caccuro* and *Nimphius*, and the requisite "clear and particular" motivation to

-18-

support a *prima facie* case of obviousness is lacking. The Examiner does not show, by substantial evidence, that a skilled artisan having the cited references before him would have been motivated to combine those references in the manner resulting in Applicant's claimed combination. The Examiner merely provides a general assertion that *Nimphius* allegedly teaches certain features and fails to provide more than conclusory statements supporting a motive for combining the reference with *Caccuro*. The Examiner alleges (OA at 3) that a skilled artisan would have combined the references "to allow for subscribers to be mobile." This conclusory statement is not properly supported by substantial evidence on the record and does not evidence that a skilled artisan would have been motivated to combine the references in a manner resulting in Applicant's claimed combination. That the combination might allow subscribers to be mobile in no way whatsoever evidences that a skilled artisan would have combined the references in a manner resulting in the invention defined by claim 1.

Applicant calls attention to M.P.E.P. § 2143.01, which makes clear that

> The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (citations omitted).

The Examiner does not show that the cited art "suggests the desirability of the" combination. No objective reason for combining the applied art to achieve the invention defined by claim 1 has been established.

Applicant notes that the requirements for establishing *prima facie* obviousness must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001). As M.P.E.P. § 2142 articulates:

> Knowledge of applicant's disclosure must be put aside....
> [I]mpermissible hindsight must be avoided and the legal
> conclusion must be reached on the basis of the facts gleaned from
> the prior art.

-19-

Applicant submits that the conclusions in the Office Action were not reached based on facts gleaned from the references. Rather, Applicant's claims were used to reconstruct the prior art. A skilled artisan would not have been motivated, without consulting Applicant's disclosure, to combine *Caccuro* and *Nimphius* in a manner resulting in the invention defined by claim 1. While *Nimphius* mentions wireless subscribers and *Caccuro* describes a voice messaging system that presents announcements based on where an incoming call originated, neither of these references teaches or suggests combining their respective teachings as alleged in the Office Action. Consequently, the conclusions in the Office Action constitute improper hindsight reasoning. For at least the reasons advanced above, the requisite motivation to combine is lacking.

Because the required motivation to combine the applied references is lacking, and since the applied references (even if combined) fail to teach or suggest each and every claim recitation, *prima facie* obviousness has not been established with respect to claim 1. The rejection of claim 1 under 35 U.S.C. § 103(a) should therefore be withdrawn. The Examiner rejected independent claims 11, 27, and 37 "for the same reasons as claim 1" (OA at 3-4). Claims 11, 27, and 37 include recitations that generally correspond to those in claim 1. For at least the reasons presented above in connection with claim 1, a *prima facie* case of obviousness has not been established with respect to claims 11, 27, and 37.

Because *prima facie* obviousness has not been established with respect to independent claims 1, 11, 27, and 37, the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn. The rejection of claims 13-16, 28, 29, 31, 32, 37-41, 43, 44, and 46 should be withdrawn as well, at least because of the respective dependence of those claims from base claims 1, 11, 27 and 37. Accordingly, Applicant requests withdrawal of the rejection of claims

-20-

1-6, 8, 10-11, 13-16, 27-29, 31, 32, 37-41, 43, 44, and 46 under 35 U.S.C. §103(a) and the timely

allowance of these pending claims.

Rejection of claims 20-22, 24-26, and 33 under 35 U.S.C. § 103(a)

Applicant traverses the rejection of claims 20-22, 24-26, and 33 under 35 U.S.C. § 103(a)

because a *prima facie* case of obviousness has not been established based on *Nimphius* and

Caccuro.

Independent claim 20 recites a combination, including:

> selecting a directory number based on the identified group and the
> detected event; and

> sending the selected directory number to the switching node such
> that the call is established from the first subscriber to the message
> node to allow the message node to provide to the first subscriber a
> message that is selected based on the directory number and a
> profile associated with the identified group.

For at least the reasons advanced above in connection with claim 1, neither *Nimphius* nor

Caccuro, nor any combination thereof teaches or suggests at least the above features of claim 20

and the requisite motivation to combine these references is lacking. Moreover, the Examiner's

allegation (OA at 5) that a skilled artisan would have combined the references to "allow for

messages to be relayed to calling subscriber when a called party is busy" is not properly

supported and does not evidence that a skilled artisan would have been motivated to combine the

references in a manner resulting in Applicant's claimed combination. The Examiner has not

shown that the cited art "suggests the desirability of the" combination. Applicant further submits

that the conclusions in the Office Action were not reached based on facts gleaned from the

references and that Applicant's claims were used to reconstruct the prior art. A skilled artisan

would not have been motivated, without consulting Applicant's disclosure, to combine *Nimphius*

and *Caccuro* in a manner resulting in the claimed invention. Consequently, the conclusions in

-21-

the Office Action constitute improper hindsight reasoning and the requisite motivation to combine is therefore lacking. For at least these reasons, a *prima facie* case of obviousness has not been established with respect to claim 20.

Independent claim 22, as currently presented, recites a combination, including:

> a structure for identifying a location register representative of an identified group and an event that indicates an error associated with a call in a wireless network when the switching node receives a request for establishing the call from a first subscriber to a second subscriber in the wireless network, wherein the structure includes a trigger indexed by a variable number of digits in a directory number of the first subscriber;

independent claim 26 recites, *inter alia*:

> computer-readable code for ... selecting, based on the detected event and the identified group, one of the stored predetermined directory numbers that is used to establish communications between the one subscriber and the message node and is used by the message node to select one of the messages to be sent to the one subscriber;

and independent claim 33, as currently presented, recites, *inter alia*:

> providing a message to the first subscriber based on the directory number, the event, and a profile associated with the subscriber group corresponding to the first subscriber.

Although claims 22, 26, and 33 are of different scope than claims 1 and 20, a *prima facie* case of obviousness has not been established with respect to these claims for at least the same reasons as those discussed above for claims 1 and 20.

Because a *prima facie* case of obviousness has not been established, the rejection of claims 20, 22, 26, and 33 under 35 U.S.C. § 103(a) should be withdrawn. Claim 21 depends from claim 20; and claims 24 and 25 depend from claim 22. The rejection of claims 21, 24, and 25 should be withdrawn at least because of the respective dependence of these claims from base

-22-

claims 20 and 22. Accordingly, Applicant requests withdrawal of the rejection of claims 20-22, 24-26, and 33 under 35 U.S.C. §103(a) and the timely allowance of these pending claims.

Rejection of claims 9, 30, and 45 under 35 U.S.C. § 103(a)

Applicant traverses the rejection of claims 9, 30, and 45 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established based on *Caccuro*, *Nimphius*, and *Garcia*.

Claim 9 depends from claim 1 and therefore includes all of the elements recited in base claim 1. In particular, claim 9, by virtue of such dependency, recites a combination including:

> determining a directory number associated with the identified group and the detected event ... and

> generating a message by the message node based on the directory number and a profile associated with the identified group.

As explained above, neither *Caccuro* nor *Nimphius*, nor a combination thereof, teaches or suggests at least the claimed "determining" and "generating" elements. Additionally, as affirmed by the Examiner (OA at 6), neither *Caccuro* nor *Nimphius* discloses executing the message in a TDD format, as claimed. *Garcia* fails to cure the deficiencies of *Caccuro* and *Nimphius*. *Garcia* describes a telephony system for "conveying audio information among patients, health care providers, pharmacy personnel and others" (col. 1, lines 5-10). *Garcia* does not teach or suggest "determining" and "generating," as recited in claim 9. Accordingly, neither *Caccuro*, *Nimphius*, nor *Garcia*, nor any combination thereof, teaches or suggests each and every element recited in claim 9. A *prima facie* case of obviousness has not been established for at least this reason.

Moreover, regarding claim 9, the requisite motivation to combine the cited references is lacking. As explained above, there is no motivation to combine *Caccuro* and *Nimphius*. In addition, Applicant submits that there is no "substantial evidence" or "clear and particular" motivation in the record to support the attempted combination of *Caccuro*, *Nimphius*, and

-23-

Garcia. The Examiner alleged that a skilled artisan would have combined the cited references "to allow deaf individuals to receive messages as suggested by *Garcia*" (OA at 6). Again, the Examiner does not show, by substantial evidence, that a skilled artisan having the cited references before him would have been motivated to combine those references in the manner resulting in Applicant's claimed combination. The Examiner merely provides a general description of how *Garcia* allegedly teaches certain features and fails to provide more than conclusory statements supporting a motive for combining the reference with *Caccuro* and *Nimphius*. The above allegation by the Examiner is not properly supported and does not evidence that a skilled artisan would have been motivated to combine the references in a manner resulting in Applicant's claimed combination.

Further, Applicant submits that the conclusions in the Office Action were not reached based on facts gleaned from the references and that Applicant's claims were used to reconstruct the prior art. *Caccuro* describes a voice messaging system that presents announcements based on where an incoming call originated, *Nimphius* mentions wireless subscribers, and *Garcia* discloses transmitting a message in TDD format. None of these references, however, teaches or suggests combining their respective teachings as alleged in the Office Action. A skilled artisan would therefore only arrive at the invention defined by claim 9 by consulting Applicant's disclosure. Consequently, the conclusions in the Office Action constitute improper hindsight reasoning and the requisite motivation to combine is therefore lacking. For at least these reasons, a *prima facie* case of obviousness has not been established with respect to claim 9.

The Examiner rejected claims 30 and 45 for the same reasons as claim 9. Claims 30 and 45 depend from claims 27 and 37, respectively, and, although of different scope, include recitations that generally correspond to those of claim 9. For at least the reasons presented above

-24-

in connection with claim 9, a *prima facie* case of obviousness has not been established with respect to claims 30 and 45.

Because *prima facie* obviousness has not be established, the rejection of claims 9, 30, and 45 under 35 U.S.C. § 103(a) should be withdrawn. Applicant therefore requests withdrawal of the rejection of claims 9, 30, and 45 under 35 U.S.C. §103(a) and the timely allowance of these pending claims.

Rejection of claims 17 and 19 under 35 U.S.C. § 103(a)

Applicant traverses the rejection of claims 17 and 19 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established based on *Gallant* and *Caccuro*.

Independent claim 17 recites a combination including:

> establishing the call from the wireline subscriber to the message node based on the received directory number and a subscriber group associated with the wireless subscriber, when an event that indicates an error associated with the call is detected.

As affirmed by the Examiner (OA at 7), *Gallant* fails to disclose the above-noted feature. *Gallant* also fails to suggest this feature. Contrary to the Examiner's position, *Caccuro* does not cure *Gallant*'s deficiencies. Even if *Caccuro* were construed as disclosing a subscriber group, the reference does not disclose "establishing the call from the wireline subscriber to the message node based on the received directory number and a subscriber group ... when an event that indicates an error associated with the call is detected," as claimed. *Caccuro*'s system merely "compares the originating country code of the caller to a stored language code selection list ... and[,] ... based on the results of the comparison, delivers the system's messages to the caller in the language that is most likely understood by the caller." Accordingly, neither *Gallant* nor *Caccuro*, nor a combination thereof, teaches or suggests all of the features recited in claim 17. A *prima facie* case of obviousness has not been established for at least this reason.

-25-

Further, a *prima facie* case of obviousness has not been established with respect to claim 17 at least because the requisite motivation to combine is lacking. There is no "substantial evidence" in the record to support the attempted combination of *Gallant* and *Caccuro*, and the requisite "clear and particular" motivation to support a *prima facie* case of obviousness is lacking. The Examiner does not show, by substantial evidence, that a skilled artisan having the cited references before him would have been motivated to combine those references in the manner resulting in Applicant's claimed combination. The Examiner merely provides a general assertion that *Caccuro* allegedly teaches certain features and fails to provide more than conclusory statements supporting a motive for combining the reference with *Gallant*. The Examiner alleges (OA at 8) that a skilled artisan would have combined the references to "allow for messages to be relayed to a calling subscriber when a called party is busy...." This allegation is not properly supported by substantial evidence on the record and does not evidence that a skilled artisan would have been motivated to combine the references in a manner resulting in Applicant's claimed combination. Applicant submits that the conclusions in the Office Action were not reached based on facts gleaned from the references and Applicant's claims were used to reconstruct the prior art. Consequently, the conclusions in the Office Action constitute improper hindsight reasoning and the requisite motivation to combine is therefore lacking. For at least these reasons, a *prima facie* case of obviousness has not been established with respect to claim 17.

Because *prima facie* obviousness has not be established, the rejection of claim 17 under 35 U.S.C. § 103(a) should be withdrawn. The rejection of claim 19 should be withdrawn as well, at least because of the dependence of that claim from base claim 17. Applicant thus requests

withdrawal of the rejection of claims 17 and 19 under 35 U.S.C. §103(a) and the timely

allowance of these pending claims.

Rejection of claim 18 under 35 U.S.C. § 103(a)

Applicant traverses the rejection of claim 18 under 35 U.S.C. § 103(a) because a *prima*

facie case of obviousness has not been established based on *Gallant, Caccuro,* and *Wheeler*.

Claim 18 depends from base claim 17 and, by virtue of such dependency, recites, *inter*

alia:

> establishing the call from the wireline subscriber to the message
> node based on the received directory number and a subscriber
> group associated with the wireless subscriber, when an event that
> indicates an error associated with the call is detected.

As explained above, neither *Gallant* nor *Caccuro*, nor a combination thereof, teaches or suggests

the above feature. In addition, as acknowledged by the Examiner, these references fail to

disclose "terminating the call established from the wireline subscriber to the message node when

a request for disconnect is received from the wireline subscriber or the message node," as recited

in claim 18. *Wheeler*, moreover, does not cure all of the deficiencies of *Gallant* and *Caccuro*.

Wheeler describes an intelligent peripheral in a video dial tone network. *Wheeler* does not teach

or suggest, for example, the "establishing" element of claim 18.

Accordingly, neither *Gallant, Caccuro,* nor *Wheeler*, nor any combination thereof,

teaches or suggests all of the elements recited in claim 18. A *prima facie* case of obviousness

has not been established for at least this reason.

In addition, a *prima facie* case of obviousness has not been established with respect to

claim 18 at least because the requisite motivation to combine is lacking. As explained above,

there is no motivation to combine *Gallant* and *Caccuro*. In addition, Applicant submits that

there is no "substantial evidence" or "clear and particular" motivation in the record to support the

-27-

attempted combination of *Gallant, Caccuro,* and *Wheeler.* The Examiner does not show, by substantial evidence, that a skilled artisan having the cited references before him would have been motivated to combine the references in the manner resulting in Applicant's claimed combination. The Examiner merely provides a general assertion that *Wheeler* allegedly teaches certain features and fails to provide more than conclusory statements supporting a motive for combining the reference with *Gallant* and *Caccuro.* The Examiner alleges (OA at 8) that a skilled artisan would have combined the references to allow "a call to be terminated whenever an IP completes reporting an event ...." This allegation is not properly supported by substantial evidence on the record and does not evidence that a skilled artisan would have been motivated to combine the references in a manner resulting in Applicant's claimed combination. Applicant submits that the conclusions in the Office Action were not reached based on facts gleaned from the references and Applicant's claims were used to reconstruct the prior art. Consequently, the conclusions in the Office Action constitute improper hindsight reasoning and the requisite motivation to combine is therefore lacking. For at least these reasons, a *prima facie* case of obviousness has not been established with respect to claim 17.

Because *prima facie* obviousness has not be established, the rejection of claim 18 under 35 U.S.C. § 103(a) should be withdrawn. Applicant therefore requests withdrawal of the rejection of claim 18 under 35 U.S.C. §103(a) and the timely allowance of this pending claim.

Conclusion

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-6, 8-11, 13-22, 24-33, 37-41, and 43-46 in condition for allowance. The proposed amendments of claims 22 and 33 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of their elements

-28-

and relationships therebetween were either earlier claimed or inherent in the claims as examined. This Amendment should therefore allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. Entry of this Amendment would allow Applicant to reply to the final rejections and place the application in condition for allowance, or in better form for appeal, should the Examiner dispute the patentability of the pending claims.

The claimed invention is neither anticipated nor rendered obvious in view of the references cited against this application. Applicant therefore requests the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

To the extent necessary a petition for extension of time under 37 C.F.R. 1.136 is hereby made. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 07-2347.

Respectfully submitted,

Dated: <u>May 26, 2004</u>
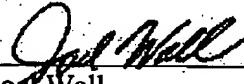
By:_____
Joel Wall
Reg. No. 25,648

Verizon Corporate Services Group Inc.
600 Hidden Ridge, HQE03H14
Irving, TX 75038
(972) 718-4800